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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,685	08/24/2000	Michinori Hirota	36595:165847	2576

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EXAMINER

CHERUBIN, YVESTE GILBERTE

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/643,685

Applicant(s)

HIROTA, MICHINORI

Examiner

Yveste G. Cherubin

Art Unit

3713

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-7 and 9 is/are rejected.
- 7) ☒ Claim(s) 8 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is in response to the communication received on January 3, 2002, in which claims 1-2 are canceled and claims 3-7 are amended.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- a. Claims 3, 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US Patent No. 4,715,604) – referred to hereinafter as Okada '604) in view of Okada (US Patent 5,083,785) or Manship et al. (US No. 5,393,061).

As per claim 3, Okada' 604 discloses a slot machine comprising a display and shift or move means for moving or shifting and displaying various kinds of symbols on a set of reels, as shown in Fig 1. During a game, each reel is caused to rotate and is stopped at one of the possible stop positions in each of which it displays corresponding symbols neighboring to each other, as shown in Fig 1, to a player through a window or an easy-viewable profile. When all the reels stop, a win decision is made based on the combinations of symbols stopping on the winning line or lines. Although Okada'604 discloses including a stop control means in his device, The Examiner notes that his stop control is automatic. Okada' 785 is cited to teach a device comprising a stop means (buttons) capable of being actuated at a desired time interval to initiate a stop control

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wherein the respective reels are stopped, whereupon a predetermined symbol combination is displayed on the effective prize winning line, 3:2-8. It would have been obvious to one of ordinary skill in the art to include the stop and display means of Okada '785 into the Okada'604 in order to provide a sense of control to players. Okada '604 further failed to disclose the use of symbol marks to form a specified symbol mark and wherein said specified symbol mark includes a first semi circular symbol mark formed in the shape of an upper half of a circular configuration and a lower half of a circular configuration to complete a circle in cooperation with a said first semi-circular symbol mark. Using such configuration to display symbols would have been a matter of design choice. For example, it's known to have half of a watermelon being used as a symbol. however, having it arranged and displayed in a way to form a circular shape would have been a matter of choice. Honestly, the Examiner does not see the difference between the symbol marks of Okada and the symbol marks of this instant claim limitation since the symbol marks of both devices are applying the same function, which is to display possible winning combinations. Besides, a symbol is a symbol and can be represented by anything one wants it to be. Relating or associating that symbol to whatever winning combination to fit one needs would have been a matter of design choice. Whatever symbols one decides to use to display the different possible winning combinations would be an obvious matter of design choice. *The only difference between the symbols of this claimed invention and the symbols in the Okada reference is size and shape of the symbols. It would have been an obvious matter of design choice to enlarge the symbols for better view, since such a modification would have involved a mere change*

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*in the size of the component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art, In re Rose, 105 USPQ 237 (CCPA 1955).* The reference is deemed to teach the claimed invention as broadly claimed. Manship is cited to teach a video slot machine including a display screen in which when the game gets into a certain mode the bells are enlarged in order to increase appeal. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the enlargement teaching of Manship into the Okada'604 type system in order to provide a better view during the fever mode and make it more appealing. As per claims 6-7, Okada '604 discloses a slot machine comprising of a plurality of rotation reels (see Fig 1), each having various kinds of symbols (see Fig 2), 2:22-28, also see elements (9, 10, 11) in Fig 2.

b. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US Patent No. 5,083,785 – referred to hereinafter as Okada '785).

As per claims 4-5, Okada '785 discloses a slot machine capable of shifting and displaying symbols as shown in Fig 1. In reference to Fig 2, the Examiner interprets the "random number segments" of the claimed invention as being the "series of numerical value" cited in Okada '785, 3:35-38, 55-64. In the instant invention, just like the random number generator is divided into a plurality of segments, each numerical value in Okada constitutes a series of numerical values ranging from the minimum numerical value "1" to maximum numerical value "4096" and wherein those numerical data correspond to a plurality of small, middle and big wins. Okada further teaches a random number

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sampler (26) for sampling the numerical values generated by the random number generator, 3:28-48; a storage means (29) for storing table data having a plurality of predetermined reference values, 3:49-50, 4:1-4; a stop control means (36) for controlling the stop of the shift and display means to have a set of symbols stopped and displayed on the basis of the winning state, 4:5-49. As for breaking the random numbers into more and more segments, one of ordinary skill in the art would have been motivated to do so in order to provide a plurality of winning chances to players.

***Claim Rejections - 35 USC § 103***

c. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada'785, alternatively, over Okada'785 in view of Manship.

As per claim 9, Okada'785 discloses the invention as substantially as explained above. Okada '785, however fails to explicitly disclose the use of symbol marks to form a specified symbol mark and wherein said specified symbol mark includes a first semi circular symbol mark formed in the shape of an upper half of a circular configuration and a lower half of a circular configuration to complete a circle in cooperation with a said first semi-circular symbol mark. Using such configuration to display symbols would have been a matter of design choice. For example, it's known to have half of a watermelon being used as a symbol. However, having it arranged and displayed in a way to form a circular shape would have been a matter of choice. Honestly, the Examiner does not see the difference between the symbol marks of Okada and the symbol marks of this instant claim limitation since the symbol marks of both devices are applying the same

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function, which is to display possible winning combinations. Besides, a symbol is a symbol and can be represented by anything one wants it to be. Relating or associating that symbol to whatever winning combination to fit one needs would have been an obvious matter of design choice. Besides, a symbol is a symbol and can be represented by anything one wants it to be. Relating or associating that symbol to whatever winning combination to fit one needs would have been a matter of design choice. Whatever symbols one decides to use to display the different possible winning combinations would be a matter of design choice. *The only difference between the symbols of this claimed invention and the symbols in the Okada reference is size and shape of the symbols. It would have been an obvious matter of design choice to enlarge the symbols for better view, since such a modification would have involved a mere change in the size of the component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art, In re Rose, 105 USPQ 237 (CCPA 1955).* The reference is deemed to teach the claimed invention as broadly claimed.

### ***Allowable Subject Matter***

3. Claims 8, 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Applicant's Arguments***

4. Applicant's arguments with respect to claims 3-10 have been considered but are moot in view of the new ground(s) of rejection.

***Final Rejection***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (703) 306-3027. The examiner can normally be reached on 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703)



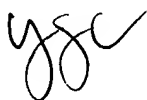
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872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

October 24, 2002

ygc



S. THOMAS HUGHES  
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